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OFFICE OF PETITIONS

In re Application of
Robert W. M. Smith, et al.
Application No. 10/791,497
Filed: March 2, 2004
Attorney Docket No. PST-10703/36

DECISION DISMISSING
PETITION AS MOOT

This is a decision on the petition filed June 8, 2004, requesting that the above-identified application retain its filing date of March 2, 2004, with an indication that Figures 8 and 9 were present on filing.

The application was deposited on March 2, 2004. However, the Office of Initial Patent Examination mailed a "Notice of Omitted Items in a Nonprovisional Application" (Notice) on March 3, 2004 stating that the application was deposited without Figures 8 and 9.

In reply to the Notice, applicant filed the instant petition stating that the application is a continuation application of Application No. 10/410,492, and that the specification in the present application incorporated by reference the parent application mentioned above, which parent application includes the missing drawing figures.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the drawing(s) at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing drawings were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted drawings in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted drawing(s) with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawing(s) and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

Clearly, Figures 8 and 9 were intended to be a part of the application, but these figures were not present in the application file on March 2, 2004, the date of deposit of the application. Therefore, the application cannot be accorded that date as the filing date with Figures 8 and 9 as part of the original disclosure. Figures 8 and 9 were simply not filed in the USPTO on that date. Accordingly, petitioner cannot retain the March 2, 2004 filing date with an indication that Figures 8 and 9 were present on filing.

MPEP 201.06(c) in pertinent part states:

"If a continuation or divisional application as originally filed is entitled to a filing date despite the omission of a portion of the prior application(s), applicant will be permitted to add the omitted material by way of an amendment provided a statement was included in the application as originally filed that incorporates by reference the prior application(s). If the application as originally filed includes a proper incorporation by reference of the prior application(s), an omitted specification page(s) and/or drawings figure(s) identified in a "Notice of Omitted Item(s)" may be added by amendment provided the omitted item(s) contains only subject matter in common with such prior application(s). In such case, applicant need **not** respond to the "Notice of Omitted Item(s)." Applicant should submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application. See MPEP § 601.01(d) and § 601.01(g).


In accordance with MPEP 201.06(c), applicant may seek to amend the application to include the omitted drawing figures. However, no petition under 37 CFR 1.182 is necessary for that purpose. The primary examiner without petition may enter new drawings so long as those drawings contain now new matter. See MPEP § 608.02(a). However, that is an issue to be raised before the examiner during the course of the examination of this application and as such will not be further considered as a filing date matter.

In view of the above, the petition is **DISMISSED AS MOOT**.

Accordingly, petitioner may request a refund of the \$130 petition fee by writing to the Office of Finance, Refund Section. A copy of this decision should accompany such a request.

This application file is being referred to the Office of Initial Patent Examination for further **processing with a filing date of March 2, 2004, including an indication in Office records that Figures 1 –7 and 10 – 15 were present on filing.**

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3223.


Marianne E. Jenkins
Petitions Examiner
Office of Petitions